1   CHUCK P. EBERTIN (SBN 161374)
      cebertin@velaw.com
2   VINSON & ELKINS LLP
    1841 Page Mill Road, Suite 200-B
3   Palo Alto, CA 94304
    Tel: (650) 687-8200 / Fax: (650) 618-1970
4
    CHRISTOPHER V. RYAN (*pro hac vice*)
5   cryan@velaw.com
    EFREN GARCIA (*pro hac vice*)
6   egarcia@velaw.com
    JANICE L. TA (*pro hac vice*)
7   jta@velaw.com
    VINSON & ELKINS LLP
8   The Terrace 7
    2801 Via Fortuna, Suite 100
9   Austin, TX 78746
    Tel: (512) 542-8400 / Fax: (512) 542-8612
10
    DAVID J. TOBIN (*pro hac vice*)
11   dtobin@velaw.com
    VINSON & ELKINS LLP
12 2001 Ross Avenue, Suite 3700
    Dallas, TX 75201
13 Tel: (214) 220-7949 / Fax (214) 999-7949
14 Attorneys for Plaintiff and Counterclaim
      Defendant SANDISK CORPORATION
15
16   UNITED STATES DISTRICT COURT
17   NORTHERN DISTRICT OF CALIFORNIA
18   SAN FRANCISCO
19

20 SANDISK CORPORATION,	Case No. 3:11-cv-05243-RS
21 Plaintiff and Counterclaim Defendant,	**SANDISK'S REPLY IN SUPPORT OF ITS MOTION TO STRIKE PORTIONS OF ROUND ROCK'S EXPERT REPORTS**
22 vs.	
23 ROUND ROCK RESEARCH LLC,	
24 Defendant and Counterclaim Plaintiff.	Date: February 13, 2014
25	Time: 1:30 p.m.
	Judge: Hon. Richard Seeborg

26
27   # REDACTED PUBLIC VERSION
28

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1   **I.   INTRODUCTION.**

2   Round Rock's decision to wait until its expert reports to accuse new products of infringement

3   and to disclose its indirect infringement theories violates both the letter and spirit of this Court's

4   Patent Local Rules. As this Court has explained,

5   The overriding principle of the Patent Local Rules is that they are designed to make
           the parties more efficient, to streamline the litigation process, and to articulate with
6   specificity the claims and theory of a plaintiff's infringement claims. . . . The Rules
           are also intended to require the party claiming infringement to crystallize its theories
7   of the case early in the litigation and to adhere to those theories once disclosed.

8

9   *Mediatek, Inc. v. Freescale Semiconductor, Inc.*, No. 11-5341 YGR (JSC), 2013 WL 588760, at *1

10 (N.D. Cal. Feb. 13, 2013) (Corley, M.J.). Round Rock fails to show its infringement contentions

11 articulated with specificity or otherwise crystallized its indirect infringement theories, that SanDisk's

12 SDIN7xx and SDIN8xx products allegedly infringe the '053 Patent, or that SanDisk's iNAND, SD

13 and microSD products allegedly infringe the '345 Patent. Indeed, in an order issued yesterday,

14 Judge Corley reviewed Round Rock's infringement contentions for the '345 Patent and held that

15 "Round Rock expressly limited its '345 claim 1 infringement contention to products involving

16 mDOC H3 datasheet revisions 1.2 and 1.3." [Dkt. No. 282 at 1:27–28.]

17   Round Rock's attempt to expand the scope of this case through its expert reports is neither

18 excusable under the Patent Local Rules nor supported by any evidence of good cause. Long before

19 fact discovery closed, Round Rock possessed the documents and other information on which its

20 experts now rely to assert infringement by the newly identified products and to describe Round

21 Rock's indirect infringement theories. Even if Round Rock were to seek leave to amend its

22 infringement contentions (which it has not), permission to amend would unfairly prejudice SanDisk

23 by depriving it of the fair notice and scope of infringement discovery guaranteed by this Court's

24 Patent Local Rules now that fact discovery is closed. For example, Round Rock's infringement

25 contentions for the '345 Patent were limited to only one category of products (mDOC), ███████

26 ██ Given the limited potential

27 exposure, SanDisk forewent certain discovery on the '345 Patent and prioritized litigation resources

28 in favor of other asserted patents. Now, Round Rock's experts have injected completely different

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1   product lines with sales of ███████ allegedly infringing units. [Mot. at 6:6–18.] ███████

2   ██

3   ██ [Ex. 15

4   (Wagner Expert Rep.) at Schedule 1.3.][1]

5   　　　　Round Rock and its experts must adhere to the theories and accused products disclosed in its

6   infringement contentions. SanDisk therefore requests that the Court strike those portions of Round

7   Rock's expert reports that add new products and new theories of indirect infringement.

8   **II.   ROUND ROCK SHOULD NOT BE PERMITTED TO ADD NEW PRODUCTS TO
9   THE '345 CASE THROUGH ITS EXPERT REPORTS.**

10   　　　　The issue of whether Round Rock's infringement contentions disclosed iNAND, SD and

11   microSD products of infringing the '345 Patent was decided by Judge Corley earlier this week. In

12   denying (in part) a motion to compel filed by Round Rock, Judge Corley held that "***Round Rock***

13   ***expressly limited its '345 claim 1 infringement contention to products involving mDOC H3***

14   ***datasheet revision 1.2 and 1.3***." [Dkt. No. 282 (Order re Round Rock Research's Mot. to Compel)

15   at 1:27–2:1 (emphasis added).] In rendering her decision, Judge Corley rejected the very arguments

16   that Round Rock makes in opposing this Motion to Strike. Similarly, courts in this District have

17   rejected the same excuses that Round Rock now offers for why it did not identify any models of

18   microSD memory cards or even mention iNAND and SD products in its infringement contentions

19   for the '345 Patent. Because Round Rock only disclosed SanDisk's mDOC products in its

20   infringement contentions, it should not be able to now accuse new products in its expert reports.

21   　　　　**A.   Judge Corley Held That Round Rock's Infringement Contentions for the '345
22   Patent Do Not Include iNAND, SD, or microSD Products.**

23   　　　　Round Rock does not dispute that "[e]ach product number (SKU) identified by Round Rock

24   in its '345 infringement contentions [for the '345 Patent] belonged ***exclusively*** to the mDOC product

25   line." [Mot. at 7:1–3 (emphasis added); *see also* Decl. of Kenneth Bell ¶¶ 3,4.][2] Indeed, none of

---

[1] The exhibits cited herein refer to those attached to the Declaration of Chuck Ebertin filed along
with this brief.

[2] Note that Kenneth Bell, an employee of SanDisk, was deposed twice in this case by Round Rock—
on October 24, 2012 and June 27, 2013.

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1   the SKUs identified by Round Rock in its '345 infringement contentions belong to the iNAND, SD,

2   or microSD product lines. [Decl. of Kenneth Bell ¶¶ 4, 5.]

3   Round Rock asserts that its infringement contentions adequately disclose microSD cards

4   because they mention the phrase "microSD memory cards," even though they do not identify any

5   specific names or model numbers of products within the microSD line, nor do they provide any

6   claim chart comparing any microSD product to any of the '345 Patent claims. [*See* Opp. at 4:12–

7   16.] Round Rock made this same argument to Judge Corley in support of its motion to compel—

8   without success.   [*Compare* Opp. Br. at 4:14–15 ("Indeed, Round Rock's identification of the

9   accused 'microSD memory cards' by name complies with the Patent Local Rules.") *with* Dkt.

10   No. 267 at 2:4–6 ("Round Rock's infringement contentions regarding the '345 patent identify

11   'microSD memory cards and mDOC H3 embedded flash drives' as infringing the '345 patent.").]

12   Judge Corley did not find the mere mention of the phrase "microSD memory cards" to be sufficient,

13   concluding that Round Rock's infringement contentions were "expressly limited" to the mDOC

14   products. [Dkt. No. 282 (Order re Round Rock Research's Mot. to Compel) at 1:27–2:1.]

15   Round Rock also tries to defend its infringement contentions by analogizing them to the

16   infringement contentions in *Infineon Techs. AG v. Volterra Semiconductor Corp.*, No. C 11-6239

17   MMC (DMR), 2012 WL 6184394, at *3 (N.D. Cal. Dec. 11, 2012). [*See* Opp. at 4.] *Infineon*,

18   however, provides an exemplary contrast Round Rock's infringement contentions and infringement

19   contentions that actually comply with the Local Patent Rules. In that case, the patent owner

20   specifically identified eighteen models of defendant's products, including photographs of those

21   products, and "provided nearly 50 pages of analysis supporting its argument that the VT1195SEQ

22   product [for which claim charts were provided] is representative of the other Accused Products."

23   *Infineon*, 2012 WL 6184394, at *4.

24   In contrast, Round Rock identified model numbers (SKUs) for only the mDOC products and

25   then provided a claim chart only against the mDOC data sheet. Indeed, Round Rock indicated that

26   its infringement analysis applied only to products compliant with the mDOC H3 datasheet, as all of

27   the exemplary SKUs cited by Round Rock in footnote 1 to its claim chart are mDOC products:

28

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> ¹ This claim chart applies to SanDisk products that comply with the mDOC H3 datasheet, revisions 1.2 (Nov. 2007) & 1.3 (May 2008), including without limitation model numbers MDxx-xx and SDEDx-x, including at least MD2534-d1G-X-P, MD2534-d1G-X-P/Y, MD2534-d2G-X-P, MD2534-d2G-X-P/Y, SDED7-256M-N9T, SDED7-256M-N9Y, SDED7-512M-NAT, SDED7-512M-NAY, SDED7-001G-NT, SDED7-002G-NT, MD2533-d8G-X-P, MD2533-d8G-X-P/Y, SDED5-001G-NAT, SDED5-001G-NAY, MD2533-d16G-X-P, MD2533-d16G-X-P/Y, SDED5-002G-NC, SDED5-002G-NCT, SDED5-002G-NCY, SDED5-004G-NC, SDED5-004G-NCT, SDED5-004G-NCY, SDED5-008G-NC, SDED5-008G-NCT, and SDED5-008G-NCY.

[Mot. at Ex. 4 (at Exhibit B, page 4); Mot. at 7:2–4, 9:5–9; *see also* Decl. of Kenneth Bell ¶¶ 3–5.] Nowhere did Round Rock suggest that its claim chart applied to or was representative of any other products.

At the hearing on Round Rock's motion to compel [Dkt. No. 243], Judge Corley noted these glaring differences in distinguishing *Infineon*:

> [W]ith respect to this claim, claim one, I mean, what does this footnote mean, and where is the 50 pages of analysis like there was in Judge Ryu's case [*Infineon Techs. v. Volterra*]?
>
> MR. COWELL: Well, this is a relatively simple patent, your Honor. We don't need 50 pages of analysis.
>
> THE COURT: To you maybe, not to me. Well, you know, it's just way too late in the day to be expanding that, and I understand you say, "Well, we got this discovery from this testimony that identified -- we found that we believe now it would -- that limitation we found the same thing." So you move to amend your infringement contentions. I mean, that's what they're there for**, but that footnote has to have some meaning. There's just nothing here that would put them on notice that it was broader than that.**

[Ex. 16 (1/23/2014 Hr'g Tr.) at 57:23–58:12 (emphasis added); *see also id.* at 55:10–25 ("[T]hey had 50 pages of analysis of how it was representative, and the same thing with Judge [Alsip *Network Protection Sciences v. Fortinet*]. Not here. To the contrary, you have a little thing at the bottom that says this is limited to the mDOC H3 data sheet revision products.")].

Round Rock resorts to a *post hoc* rationalization, arguing that the newly accused product lines █████████████████████████████████

██████████ [Opp. at 5:8–6:7.]   However, courts in this District have already rejected such an argument. For example, in *Oracle Am. v. Google Inc.*, No. C 10–03561 WHA, 2011 WL 4479305,

1   (N.D. Cal. Sep. 26, 2011), the infringement contentions accused "mobile devices running Android.

2   . . .   Representative examples of other mobile devices running Android include HTC's EVO 4G,

3   HTC's Droid Incredible, HTC's G2, Motorola's Droid, and Samsung's Captivate."   *Oracle*, 2011

4   WL 4479305 at *1.   The expert report then "referenced three devices that were not specifically

5   named in this list: the LG Optimus, the HTC Droid Incredible 2, and the Motorola Atrix."   *Id.* at *2.

6   In response to a motion to strike portions of its expert reports, "Oracle emphasize[d] its theory that

7   all devices running Android function the same way in all relevant respects."   *Id.*   [*Compare* Opp. at

8   5:3–5 ("Round Rock's expert was able to determine through the available discovery that the SD and

9   iNAND products also include the accused structure, and explained how they are substantially the

10 same").].   Nonetheless, the Court granted the motion to strike, explaining that because the "LG

11 Optimus, the HTC Droid Incredible 2, and the Motorola Atrix were not among the products

12 specifically identified in Oracle's disclosure of accused products, Oracle may not now accuse them

13 of infringement."   *Oracle*, 2011 WL 4479305 at *2.   So too, Round Rock "could have and should

14 have specifically identified all such accused devices" in its infringement contentions.   *See id.*

15   **B.   Round Rock Still Has Not Shown Good Cause for Failing to Identify and Chart
                          Specific iNAND, SD, or microSD Products.**
16

17   Patent Local Rule 3-1(b) requires that the "identification shall be as specific as possible."

18 [Opp. at 5:1 (emphasizing "as possible").]   Long before the close of fact discovery, it was well

19 within Round Rock's capabilities to identify specific iNAND products, specific SD products, and

20 specific microSD products.   Indeed, Round Rock accused specific models of iNAND, SD, and

21 microSD product of infringing other patents, but not the '345 Patent.   For example, Round Rock's

22 infringement contentions for the '053 patent (served June 29, 2012) specifically identify 60 different

23 model numbers (SKUs) of iNAND products.   [Opp. at 7:1–15; Opp. Ex. 4.]   Similarly, Round

24 Rock's infringement contentions for the '839 Patent identify 12 model numbers of microSD

25 products.   [Opp. at Ex. 5 (accusing "SanDisk's microSD Memory Cards, including without

26 limitation model numbers SDSDx-x, including at least SDSDQ-64 . . .").]   Last, Round Rock's

27 infringement contentions for the '344 Patent (and other patents) identify "SanDisk *SD flash memory*

28 *cards* with a UCPC2A controller, including without limitation model numbers SDSDx-x, including

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1   at least the . . . SanDisk Extreme SDHC flash memory card SDSDX3-016G-A31." [Mot. at Ex. 4

2   ('344 infringement contentions) at 3:3–6.]   If Round Rock was able to identify specific model

3   numbers of iNAND, microSD, and SD products as infringing other patents, Round Rock could have

4   (and should have) made the same specific identification for the '345 patent.

5   Though Round Rock had enough technical information to accuse the iNAND, SD, and

6   microSD products of its infringing its other patents, Round Rock argues that with respect to the '345

7   Patent, it "could not ascertain what other SanDisk products included the accused structure without

8   discovery."   [Opp. at 4:22–23; *see also id.* at 5:3–5.]   Yet Round Rock does not identify any

9   allegedly missing discovery.   In contrast, SanDisk devoted an entire section of its opening brief to

10   explaining how SanDisk provided discovery as to iNAND, microSD and SD products (including

11   over 13,000 pages of technical documents describing the functionality of flash memory controllers

12   for SanDisk products such as iNAND, SD, and microSD products) at least one year before close of

13   fact discovery, and how SanDisk put Round Rock on notice that it had accused only the mDOC

14   Products using the ▮▮▮▮ controller of infringing the '345 Patent.   [*See* Mot. at 8:18–10:11.]   Round

15   Rock does not dispute these facts.

16   ▮▮

17   ▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮▮   ▮▮▮▮▮▮▮

18   This deposition occurred almost three months before the close of fact discovery on November 21,

19   2013 [*see* Dkt. No. 241], but Round Rock chose not to seek leave to amend its '345 infringement

20   contentions to add the newly accused iNAND, SD, and microSD products.   *See Monolithic Power*

21   *Sys. v. O2 Micro Int'l Ltd.*, No. C 08-04567 CW, 2009 33453306, at *2 (N.D. Cal. 2009) (striking

22   expert report and denying motion to amend contentions because "O2 Micro had information on these

23   products about three months before it filed its current motion [to amend.]   Nevertheless, O2 Micro

24   waited until after discovery before seeking leave to accuse them.").

25   As Judge Corley remarked with respect to expanding the '345 infringement contentions to

26   cover products other than mDOC, "it's just way too late in the day to be expanding that."   [Ex. 16

27   (1/24/2013 Hr'g Tr.) at 58:5–6.]   Fact discovery is closed, and Round Rock "may not now accuse

28   the[se additional products] of infringement."   *Oracle*, 2011 WL 4479305, at *2.

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III. ROUND ROCK SHOULD NOT BE PERMITTED TO ADD NEW PRODUCTS TO THE '053 CASE THROUGH ITS EXPERT REPORTS.

Round Rock argues that because its infringement contentions identify a class of products, it need not identify specific members of that class: "SanDisk's assertion that its SDIN7xx-x and SDIN8xx-x products were not accused is thus without merit—Round Rock accused all model numbers with the prefix 'SDIN'." [Opp. at 7:17–18.] But that is not the law in this District. As the *MediaTek* case discussed, Patent Local Rule 3-1 requires a "*specific* identification of particular accused products." 2013 WL 588760 at *1 (emphasis in original). Judge Corley further explained that "a party claiming infringement must do everything it reasonably can do to identify all accused products in its PICS." *Id.* Round Rock fails to address the *MediaTek* case in its Opposition, and the only case Round Rock cites to support its novel reading of Local Patent Rule 3-1 is inapposite. In the *Network Protection Sciences v. Fortinet, Inc.* case, the infringement contentions "listed all of the accused products individually and used the FortiOS 4.0 MR2 product as a representative example." No. C 12-01106 WHA, 2013 WL 5402089, at *2 (N.D. Cal. Sep. 26, 2013). Round Rock's infringement contentions, in contrast, do <u>not</u> list "all of the accused products individually." The infringement contentions do not identify any iNAND products that begin with either an SDIN7 or SDIN8 prefix. [*See* Opp. at 7:1–15.]

Round Rock excuses its failure to identify any SDIN7xx and SDIN8xx products in its infringement contentions by arguing that "when supported by adequate analysis showing the accused products share the same critical characteristics, representative infringement contentions may suffice." [*See* Opp. at 8:14–17 (quoting *Network Protection Sciences*, 2013 WL 5402089, at *3).] Round Rock further argues that "the relevant portions of the accused iNAND eMMC embedded flash drives are the same, as described in Round Rock's expert reports." [Opp. at 8:10–12.] However, the "merits of [Round Rock's] theory are irrelevant to the question of whether [Round Rock's] disclosures adequately supported the infringement accusations in the [expert] report." *Oracle*, 2011 WL 4479305, at *2 (striking portion of expert report that "referenced three devices that were not specifically named in" the infringement contentions, even though "Oracle emphasizes its theory that all devices running Android function the same way in all relevant respects"); *cf. Infineon*

1 *Techs.*, 2013 WL 5366131, at *4 (refusing to strike contentions because "[i]n this version of its

2 infringement contentions, Plaintiff has provided nearly 50 pages of analysis . . . that the VT1195SEQ

3 product is representative of the other Accused Products"); *CSR Tech. Inc. v. Freescale*

4 *Semiconductor*, No. C-12-02619 RS (JSC), 2013 WL 503077, at *4 (N.D. Cal. Feb. 8, 2013)

5 ("Plaintiff's assertion that it 'has identified and charted a specific Freescale product . . . and has

6 stated that it is accusing any similarly designed products' is not enough to satisfy Rule 3-1(c)'s

7 explicit requirement that a plaintiff identify the limitations within *each* Accused Instrumentality.").

8   Not only does Round Rock fail to provide any analysis in its infringement contentions as to

9 why the identified products are representative of the non-identified SDIN7xx and SDIN8xx

10 products, but Round Rock's infringement contentions actually lead to the opposite conclusion.

11 Round Rock states in its infringement contentions for the '053 patent, "***This chart applies to***

12 ***SanDisk iNAND eMMC EFDs that comply with JEDEC Standard JESD84-4.41***, including

13 without limitation model numbers SDINxxx-x, including at least [identification of model numbers].

14 [Mot. Ex. 4 at Exhibit L p. 4 (infringement contentions for '053 patent) (emphasis added); *see also*

15 Opp. at 7:3–4.] Thus, Round Rock put SanDisk on notice that it expressly limited its infringement

16 contentions to those products which complied with JESD84-4.41. [*Accord* Dkt. No. 282 at 1:27–2:1

17 (Judge Corley determining that the language "This claim chart applies to SanDisk products that

18 comply with the mDOC H3 datasheet, revisions 1.2 . . . & 1.3" had the effect of "Round Rock

19 expressly limit[ing] its '345 claim 1 infringement contention to products involving mDOC H3

20 datasheet revisions 1.2 and 1.3").] Further, Round Rock's expert admits ████████████████

21 ██

22 ██

23   ██

24   ██

25   ██

26 ████████████████████████████████████ Thus, Round Rock failed to identify the

27 SDIN7xx and SDIN8xx products in its infringement contentions, and it also failed to provide claim

28 charts representative of those products.

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1   Round Rock's unsupported allegation that it "listed every individual model number it knew

2 at the time" is demonstrably incorrect. [*See* Opp. at 8:5–6.] For example, Round Rock does not

3 dispute that the "very document that Zeidman relies on to support his infringement assertions for the

4 SDIN7XX and SDIN8XX products [SAN00017921] was produced over one year ago, on

5 November 12, 2012." [Mot. at 11:11–13; *see also* Mot. Ex. 9 (11/12/2012 Lett. encl. production

6 with Bates range SAN00017848–17959).] Round Rock also does not dispute:

7   Nine months before it sought leave to amend its contentions for the '053 patent,
       Round Rock possessed the document that allegedly supports its infringement claims
8   against the SDIN7XX and SDIN8XX products, yet Round Rock chose not to include
       the SDIN7XX and SDIN8XX products among the new products it was adding to its
9   infringement contentions.

10

11 [Mot. at 11:20–24.] Accordingly, even if Round Rock were to seek leave to amend its infringement

12 contentions, the "Court cannot disregard [Round Rock's] tardiness," and because the SDIN7xx and

13 SDIN8xx products "are not mentioned in the Infringement Contentions," they should be stricken from

14 the expert reports regarding the '053 Patent. *See Monolithic Power*, 2009 WL 3353306, at *2, *3.

15 **IV.   ROUND ROCK SHOULD NOT BE PERMITTED TO DESCRIBE ITS INDIRECT
       INFRINGEMENT THEORIES FOR THE FIRST TIME IN ITS EXPERT REPORTS.**

16   **A.   Round Rock's Indirect Infringement Allegations Are Boilerplate and Fail to
17   Comply with Local Patent Rule 3-1(d).**

18   Round Rock's infringement contentions accused SanDisk of inducement and contributory

19 infringement of 12 patents from 11 different patent families. [Mot. Ex. 4.] These 12 patents covered

20 multiple technologies, including semiconductor processing ('344, '760, '209, '282 patents),

21 semiconductor packaging ('839, '528, '520 patents), and various memory technologies ('345, '586,

22 '791, '334, and '053 patents). [*See* Dkt. No. 108 (Round Rock's Opening Claim Construction Br.)

23 (containing multiple sections entitled "Background of the . . . Patent Technology").] Despite the

24 different technologies, Round Rock does not dispute that it "provided nearly identical [indirect

25 infringement] assertions regarding" the '345, '893, '791, and '053 patents. [Mot. at 12:10–13:5; *see*

26 *also* Dkt. No. 267 at 11 n.11 (admitting that Round Rock's "indirect infringement theories are

27 similar for the other patents in suit.").] The fact that Round Rock provided nearly identical indirect

28 infringement contentions across multiple technologies and numerous patents belies Round Rock's

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1   argument that it "described the acts of SanDisk that contribute to and induce the direct infringement

2   of its customers." [*See* Opp. at 9:4–5.] "Boilerplate language of indirect infringement will not

3   satisfy Patent Local Rule 3-1(d)." *France Telecom, S.A. v. Marvell Semiconductor, Inc.*, No. 12-cv-

4   04967 WHA (NC), 2013 WL 1878912, at *5 (N.D. Cal. May 3, 2013).

5   Though courts have interpreted Local Patent Rule 3-1(d) to not require a specific

6   identification of every customer, they nonetheless have required "a description of the acts of the

7   alleged direct infringer," and the "role of each party must be described." *Id.* at *5. Round Rock has

8   not provided any such description in its infringement contentions. Instead, Round Rock alleges it

9   described "the dissemination of promotional and marketing materials, supporting materials,

10   instructions, product manuals, and technical information concerning the accused products." [Opp. at

11   9:5–8.] However, courts in this District have already rejected such boilerplate descriptions:

12
13   > ***Creagri fails to identify what advertisements and instructions lead to what***
   > ***infringing behavior.*** Although Creagri is not obligated to identify the third-party
   > infringers, it must still disclose how exactly it believes Pinnacle indirectly or
14   > contributorily infringed on the '599 Patent. Its boilerplate language does not suffice.

15   *Creagri, Inc. v. Pinnacle Life, Inc.*, No. 11-cv-06635-LHK-PSG, 2012 WL 5389775, at *5 (N.D.

16   Cal. Nov. 2, 2012); *see also France Telecom*, 2013 WL 1878912, at *5 (quoting *Creagri*); *Bender v.*

17   *Maxim Integrated Prods., Inc.*, No. C 09-01152 SI, 2010 WL 2991257, at *4 (N.D. Cal. July 29,

18   2010) ("Plaintiff states that Maximum 'teaches, instructs, and explains in its datasheets' how to carry

19   out acts of direct infringement, but does not identify the data sheets or the specific products to which

20   he refers [and thus] fails to provide adequate notice . . . ."). So too, Round Rock's infringement

21   contentions did not identify which materials, instructions, product manuals, and the like allegedly

22   lead to what infringing behavior. Similarly, Round Rock accused SanDisk of inducing its customers

23   to import products into the United States [Mot. at 12:14–17], but Round Rock provided no

24   information as to how SanDisk encouraged its customers to import products into the United States.

25   For example, Round Rock's infringement contentions provided no description of how SanDisk

26   induces ███████████████████████████

27   ████████████████████   By including the same language regarding advertising and

28   marketing in each of its indirect infringement contentions across 12 patents spanning different

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1 technologies, Round Rock's indirect infringement allegations are nothing more than the boilerplate

2 disclosures held to be insufficient in this District.

3 Round Rock attempts to compare its deficient indirect infringement contentions to the

4 contentions in *DCG Sys.*, but those contentions contained far more information than Round Rock's

5 boilerplate indirect infringement contentions.   [*See* Opp. at 10 (relying on *DCG Sys., Inc. v.*

6 *Checkpoint Techs., LLC*, No. CV 11 3792 PSG, 2012 WL 1309161, at *1 (N.D. Cal. Apr. 16,

7 2012).]   The contentions in *DCG* identify "examples of other devices that are not necessarily

8 provided by [defendant], but may be used in in [sic] conjunction with the accused products in a

9 manner that infringes the asserted claims. These examples include: automated testing equipment, a

10 cooling system, a computer, and a spectrum analyzer." [Opp. at 10:13–15.] In fact, the infringement

11 contentions at issue in the *DCG* case even provide on an element-by-element basis which products

12 are combined with the accused infringer's products in order to infringe the claims, and do not recite

13 the same indirect infringement allegations across multiple patents.

Exhibit A – Claim Chart for U.S. Patent No. 7,224,828

This infringement chart relates to the InfraScan 300TDE and InfraScan 300INV (collectively "Checkpoint 300-Series Products"). This chart refers to products, structures, and functionalities described, in part, in Ex. 1, Ex. 2, Ex. 3, and Ex. 5.

Claims	Infringement Contention
15(a). A method for testing a chip while simulating normal operating conditions of said chip, comprising:	The Checkpoint 300-Series Products are devices for testing a semiconductor chip while stimulating that chip with electrical signals.
15(b). coupling said chip to an Automated Testing Equipment (ATE);	The Checkpoint 300-Series Products are designed to be used in conjunction with an automated test equipment (ATE). The ATE is connected with the device under test (DUT). Checkpoint provides instructions for and otherwise assists its customers in integrating ATEs with the Checkpoint 300-Series Products.

Exhibit D – Claim Chart for U.S. Patent No. 7,492,529

This infringement chart relates to the InfraScan 300TDE, InfraScan 300INV, and InfraScan ES (collectively "Checkpoint SIL Products"). The following chart refers to structures and functionalities described, in part, in Ex. 1, Ex. 2, Ex. 3, Ex. 4, and Ex. 6.

Claims	Infringement Contention
1(a). A method for testing a semiconductor chip, comprising:	The Checkpoint SIL Products are devices for testing semiconductor chips.
1(b). placing the chip in a test bench;	The Checkpoint SIL Products include a testing platform on which to place the device under test (DUT).
1(c). providing electrical connectivity to the chip and provide electrical signals via the connectivity;	The Checkpoint SIL Products are designed to collect photons emitted by the transistors of the DUT. Photons are emitted by the transistors of the DUT when it receives electrical signals. Those signals are provided using the Automated Testing Equipment (ATE). The Checkpoint SIL Products are designed to be used in conjunction with an ATE. The ATE is electrically coupled to the DUT to provide such signals.

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DCG Sys., No. CV 11 3792 PSG, Dkt. No. 36 (filed Dec. 22, 2011); *see also DCG Sys.*, 2012 WL 1309161 at *1 n. 3 (citing to Dkt. No. 36). In contrast to the infringement contentions in *DCG*, Round Rock's infringement contentions fail to describe, for example, "(c) how SanDisk's products are especially made or adapted to infringe the patents; (d) what other products must be combined with SanDisk's products in order to infringe the patents; and (e) why SanDisk's products are not staple articles of commerce." [Mot. 13:8–11.][3]

B. Round Rock Still Has Not Shown Good Cause For Failing to Describe Its Indirect Infringement Theories.

This is not a case in which "SanDisk asserts for the first time now, after the close of fact discovery, that Round Rock should have provided more detail." [*See* Opp. at 8:19–21.] As SanDisk previously explained, it sent multiple letters informing Round Rock that its indirect infringement allegations were not properly part of the case, because Round Rock's infringement contentions had not "described any acts of SanDisk with regard to any particular direct infringer that allegedly induced that infringement." [Ex. 14; *see also* Ex. 13; Mot. at 4:10–12; 15:26–16:5.] Yet Round Rock chose to wait until its expert reports to provide its indirect infringement theories.

Well before the close of fact discovery, Round Rock possessed the information that its experts are now using to disclose Round Rock's indirect infringement theories [Mot. at 15–16], and Round Rock does not point to any specific discovery it was allegedly missing. Moreover, this is not a case in which "[n]o discovery responses or documents were due prior to the date the infringement contentions were served." *See DCG Sys.*, 2012 WL 1309161 at *1. Rather, as SanDisk described in its Motion (and which Round Rock has not disputed), the sales information relied upon by Round Rock's experts was produced in February 2013 and further supplemented in May 2013. Similarly, Round Rock's experts cite extensively to the deposition testimony of Mr. Hinojos, who was deposed

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[3] The *Genentech* decision relied upon by Round Rock is inapposite. [Opp. at 9:15–19.] That case analyzed whether "the challenged report section merely provides an evidentiary example or complementary proof in support thereof, or itself advances a new or alternate means by which the jury could find the claim at issue invalid." *Genentech, Inc. v. Trs. Of the Univ. of Penn.*, No. C 10-2037 LHK (PSG), 2012 WL 424985, at *2 (N.D. Cal. Feb. 9, 2012). The court "accept[ed] Genentech's disavowal of any intention to rely on the [new theory] for a § 112 defense" and allowed the new theories and prior art only "for laying an historical foundation." *Id.* at *3. Round Rock, in contrast, has not limited itself to using indirect infringement merely for historical foundation.

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1   back in June 2013.   [Mot. at 15:14–25.]   Unlike Round Rock, "DCG tendered its proposed

2   amendments a few weeks after it received" the discovery it allegedly needed and several months

3   before the close of fact discovery. 2012 WL 1309161 at *3. In contrast, Round Rock chose not to

4   provide the required disclosures of its indirect infringement theories during fact discovery. Round

5   Rock's decision to withhold its indirect infringement theories is particularly egregious because <u>after</u>

6   Round Rock received the discovery it now relies upon (e.g., SanDisk sales information and Hinojos

7   deposition testimony), it did seek and obtain leave to amend its infringement contentions to accuse

8   additional products. [Dkt. No. 186.] Yet Round Rock chose not to amend its indirect infringement

9   contentions to comply with Local Patent Rule 3-1(d). Instead, Round Rock chose to provide notice

10   to SanDisk of its infringement theories for the first time in its expert reports.

11   **V.   STRIKING PORTIONS OF ROUND ROCK'S EXPERT REPORTS IS THE**
     APPROPRIATE REMEDY.

12

13   Incredibly, Round Rock suggests that SanDisk somehow waived its ability to object by

14   failing to challenge the sufficiency of Round Rock's infringement contentions. [Opp. at 1:21–2:2.]

15   However, SanDisk does not need to move to compel Round Rock to comply with the Paten Local

16   Rules, as the Patent Local Rules are mandatory and not optional. *See* Patent L.R. 3-1 ("[A] party

17   claiming patent infringement *shall* serve on all parties [a] 'Disclosure of Asserted Claims and

18   Infringement Contentions' [that] *shall* contain . . . ." (emphasis added)). Thus, Round Rock was

19   already under a duty to comply with the Local Patent Rules. *Accord Prof'l Programs Grp. v. Dep't*

20   *of Commerce*, 29 F.3d 1349, 1353 (9th Cir. 1994) ("Local rules have the 'force of law' and are

21   binding upon the parties and upon the court."); *Life Techs. Corp. v. Biosearch Techs.*, 2012 WL

22   1600393, at *3 n.7 (N.D. Cal. 2012) ("Local rules 'have the force of law,' . . . and patent local rules,

23   in particular, are vital to the pretrial process."); Fed. R. Civ. P. 16(f)(C).

24   Moreover, as it pertains to the '345 and '053 patents [Mot. at §§ II.B, II.C], SanDisk had no

25   reason to file a motion to compel because SanDisk is not arguing that the infringement contentions

26   "were unclear or inadequate." Rather, SanDisk is seeking to strike Round Rock's expert reports

27   because they "added new accused products." *See Oracle* 2011 WL 4479305, at *2, *3 (striking

28   expert report and ordering that "Oracle's infringement theories may be directed only toward accused

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1 products that were specifically named in its April 2011 disclosure of infringement contentions" and

2 that because certain models of products "were not among the products specifically listed therein,

3 Oracle may not now accuse them of infringement").[4] SanDisk "could not have known, much less

4 waived, this argument until the report[s] w[ere] served." *See Oracle*, 2011 WL 4479305, at *2.

5 The accused infringers in the cases cited by Round Rock sought for the plaintiff to provide

6 more specific claim charts, as opposed to challenging the addition of new products as here. *See CSR*

7 *Tech.*, 2013 WL 503077, at *3 ("Plaintiff's ICs are insufficient under Rule 3-1(c) because the ICs

8 point to general functionality and improperly assume the existence of each claim limitation in

9 Freescale's products" (internal quotations and annotations omitted)); *Creagri*, 2012 WL 5389775, at

10 *4 ("Creagri is obligated to make these contentions more specific."); *Shared Memory Graphics LLC*

11 *v. Apple, Inc.*, 812 F. Supp. 2d 1022, 1025 (N.D. Cal. 2010) (finding infringement contentions "too

12 vague to provide fair notice as to what components and circuitry of the accused products infringe

13 their patents"). Round Rock sought and received leave in July 2013 to amend its contentions to add

14 new products for the '053 patent [Dkt. No. 186], yet Round Rock chose <u>not</u> to amend its contentions

15 to identify models from the iNAND, SD, and microSD product lines of infringing the '345 Patent or

16 to identify the iNAND models beginning with an "SDIN7" and "SDIN8" prefix of infringing the

17 '053 patent.

18 In addition, SanDisk notified Round Rock that its indirect infringement allegations were not

19 properly part of the case, because Round Rock "did not describe the acts of SanDisk with regard to

20 any particular direct infringer that allegedly induced that direct infringement. Those contentions

21 were served over 11 months ago and Round Rock has never sought Court approval to supplement

22 those contentions, despite the fact that discovery was originally scheduled to conclude on May 31,

23 2013." [Mot. at Ex. 13 (letter from C. Ebertin dated June 14, 2013); *see also* Mot. at Ex. 14.]

24 Round Rock sought and received leave to amend its infringement contentions to add new products in

25

26 _____

[4] Round Rock argues that in "*Monolithic Power*, unlike here, the patentee sought to add brand new products by amending its infringement contentions after the close of fact discovery. *See Monolithic Power Sys. v. O2 Micro Int'l Ltd.*, No. C 08-04567 CW, 2009 WL 33453306, at *3 (N.D. Cal. Oct. 16, 2009)." [Opp. at 2:23–27.] This distinction only highlights the appropriateness of striking portions of Round Rock's expert reports, because Round Rock never sought leave to amend, either before or after the close of fact discovery.

27

28

1   July 2013, yet Round Rock chose not to amend its indirect infringement contentions. [*See* Dkt.

2   No. 186.]

3   **VI.   CONCLUSION.**

4   Accordingly, the appropriate remedy in this case is to strike those portions of Round Rock's

5   expert reports disclosing products that were not specifically identified in the infringement

6   contentions, and to strike the portions addressing indirect infringement.

7

8   Dated: January 30, 2014   VINSON & ELKINS LLP

9

                                                  By: */s/ Chuck P. Ebertin*
10   Chuck P. Ebertin

11   Attorneys for Plaintiff and Counterclaim
                                                        Defendant, SANDISK CORPORATION
12

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16   **CERTIFICATE OF SERVICE**

17   The undersigned certifies that on January 30, 2014, the foregoing document was filed with

18   the Clerk of the U. S. District Court for the Northern District of California, using the court's

19   electronic case filing system (ECF), in compliance with Civil L.R. 5-1. The ECF sends a Notice of

20   Electronic Filing (NEF) to all parties and counsel who have appeared in this action and who have

21   consented under Civil L.R. 5-1 to accept that NEF as service of this document.

22

23   /s/ *Chuck P. Ebertin*
                                                        Chuck P. Ebertin
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